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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 575,377	05 22 2000	James J. Hickman	215177-00101	2330

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PATENT ADMINSTRATOR  
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EXAMINER

ALLEN, MARIANNE P

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 04 15 2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/575,377

Applicant(s)

HICKMAN, JAMES J.

Examiner

Marianne P. Allen

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 02 April 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: 15-17 and 20-22.

Claim(s) rejected: 1-14, 18, 19, 23-27 and 50.

Claim(s) withdrawn from consideration: 28-49.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See Continuation Sheet

*Marianne P. Allen*  
Marianne P. Allen  
Primary Examiner  
Art Unit: 1631

Continuation of 2. NOTE: Proposed amendments to claims 15, 17, and 20 with respect to "which elements" results in a lack of antecedent basis for any elements. Proposed amendment to claim 23 is confusing in that the device in the system of claim 1 has parts (a)-(c) but the system has no recited subparts. The proposed amendment to claim 27 does not overcome the rejection under 35 USC 112, 2nd paragraph, as the amendment does nothing to clarify the specific information required to be provided as set forth in the prior Office action.

Continuation of 10. Other: Applicant states that a supplemental declaration was submitted. However, the second page of the declaration (including the inventor signature) was not provided. Applicant's response does not address the fact that Figure 6A-B of Jung et al. is the same as Figure 1A-B of the instant application reflecting that the exemplified electrode in the specification is the same as that of the prior art. The figures do not merely reflect two action potentials. The traces are superimposeable. Applicant is reminded that because the PTO lacks laboratory facilities, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). Applicant argues that platinum black would not permit a high impedance seal; however, as set forth in the prior Office action, the specification at page 17 indicates that the active surface of the electrodes of the invention can have platinum black. This appears to contradict applicant's assertion. Applicant is not entitled to the priority date of the provisional application for reasons of record. Page 39 of the provisional application does not disclose nor contemplate the invention as generically claimed in the instant application. Note at least for example that page 39 discusses embryonic and CNS stem cell line neuronal cells whereas the claims are directed more generally to electrically active cells. There is no generic disclosure of a device having (a) a solid state microelectrode, (b) a cell culture with the recited characteristics, and (c) an intervening layer with the recited characteristics as set forth in claim 1 or any of the dependent claims. Applicant continues to improperly rely upon the definition of a high impedance seal as being one that reduces the lateral flow of ions across the microelectrode from the surrounding medium while permitting the vertical flow of ions. Again, the claims are not limited to this definition. This is a PREFERRED embodiment of a high impedance seal as is clearly set forth in the specification at page 8. If this is the high impedance seal that applicant wants the claims to be limited to, then the claims should include these limitations.